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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,362	10/14/2003	Joseph A. Zupanick	067083.0283	9284
26231	7590	07/28/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			STEPHENSON, DANIEL P	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/687,362	Applicant(s) ZUPANICK, JOSEPH A.	
	Examiner Daniel P. Stephenson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 10, 15-18 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 5-8, 11-14, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 9, 10, 15-18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russ in view of Hogue. Russ discloses a method for removing particulate laden fluid in which a downhole device is positioned. The device contains a pump (22) and an agitator (28). The agitator agitates the fluid as it is being pumped out of the downhole cavity. The downhole device is put through a wellbore into a subsurface cavity. The agitator is made of a plurality of arms that are outwardly extendable. The pump and inlet are indirectly coupled with the agitator. The pump is operated while the reamer is operated. It does not disclose lowering the device into fluid of a subterranean cavity of a subterranean zone. Hogue discloses a method of lowering a downhole device having a fluid agitator into the cavity of a subterranean zone. The device has a winching system (21,22) that allows it to be adjusted vertically while it is rotated. The fluid within the cavity is agitated with the downhole device, by the outwardly extending arms. These arms actuate to a diameter that is greater than the wellbore diameter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the apparatus of Russ with the winching system of Hogue. This would be done to revitalize the wellbore as taught by Hogue.

With regards to claim 9 and 18, the inlet of the pump would be “operable to be longitudinally adjusted” along with the rest of the apparatus as it would be raised and lowered by the winching system of Hogue.

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In addition, it is noted that the whole apparatus inherently “operable to be longitudinally adjusted after extending the arms”. This is inherent because if repairs were needed to the equipment it would be necessary to remove it from the wellbore, thus longitudinally adjusting it after the expansion of the arms.

It is noted that there is no specific language within the claims that states that the method steps have to be performed in the order that they are listed in the claim.

With regards to claims 16 and 17, it is Officially Noticed that it is notoriously conventional to use a variety of pumps in the wellbore art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a downhole pump or suction rod pump on the apparatus of Russ in view of Hogue. This would be done provide a variety of pumping methods based on design of the wellbore.

It is noted that this is a reiteration of the Official Notice made in a previous action, and as such is now considered to be prior art.

Allowable Subject Matter

3. Claims 5-8, 11-14, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive with regards to all of the rejections.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant must consider the combination of Russ and Hogue in that Hogue would provide for the lowering and raising of the device of Russ.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS 


William Neuder
Primary Examiner